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APPLICATION NO. 09/207,282	FILING DATE 12/08/98	CONBOY FIRST NAMED INVENTOR	M	11729.184USO
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BUTLER, M
EXAMINER

3651
ART UNIT

PAPER NUMBER

06/19/01

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/207,282

Applicant(s)

Conboy et al.

Examiner

Michael E. Butler

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED May 31, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY (check only a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

It raises new issues after final necessitating a new search and/or consideration as discussed in paper 11 (the timeliness requirements of MPEP 716.01 prevent diversionary sandbagging to protracted prosecution); and failing to adequately address the rejections of claims 10-18. The examiner reiterates that the claims fail to distinguish over the combined teachings of Iwasaki et al., Burney et al., and Tau et al.

No double patenting rejection was applied to claims 10-18 as they are patentably distinct from the claims of Conboy et al. '566- the apparatus may be used in conjunction with another process and the methods may be used with a different apparatus. An absence of a restriction requirement is not a preclusion to patentable distinction-the examiner has the discretion of absorbing any burden of examining multiple inventions. Applicant's assertion in paper 6 that the amended claims 10-18 were not obvious over the disclosure of Conboy et al. '566 estopps him from asserting those claims merit a double patenting rejection, especially in view of applicant's challenge of the examiner's official notice on claim 18 of paper 5 and requirement to find and produce a reference showing that the separate element was known in the art.

It is further noted that applicant failed to pay the appropriate extension fee.

7. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1-20

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
11. ☐ Other: _____

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